

ATTORNEY DOCKET: CBZ-1266

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application STEFAN BOEGL	)	Examiner S. MCDONALD
	)	
	)	Art Unit: 3617
Serial No.: 10/517,711	)	
	)	Deposit Account: 04-1403
Filed: DECEMBER 10, 2004	)	
	)	Customer No.: 22827
Confirmation No.: 4636	)	

Title: METHOD AND DEVICE FOR THE PRODUCTION OF A PRECISE CONCRETE PREFABRICATED PART

**APPLICANT'S REPLY TO EXAMINER'S ANSWER**

MAIL STOP APPEAL BRIEF - PATENTS  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Applicant hereby submits a reply to the Examiner's Answer mailed on January 26, 2007.

Reply Argument:

Page 6, lines 7-9 of the Examiner's Answer states:

As the Examiner noted in the previous action, the “add on elements” are being interpreted to mean anything added into the grooved concrete, ground by the roller, for the insertion of the fixed track.

Page 3 of the Examiner's Answer states that DE 19753705 (hereafter DE '705) teaches (emphasis added):

Using a grooved roller, 30, or a plurality of grooved rollers, to grind connection surface to an actual dimension of the connecting surface, for **add on elements**, 5, of the fixed track \* \* \* \*.

The Final Action asserts that the elements designated 5 in DE '705 are “add on elements.” However, in so doing, the Final Rejection ignores the express identification of the DE '705 reference, which identifies elements 5 as “profile elements.” This is apparent from page 7 of Applicant's Appeal Brief containing a passage wherein DE '705 identifies elements 5 as “profile elements.” Thus, the Final Rejection is founded upon a misstatement of the express provisions of the reference.

By expressly relying on the assertion that the elements 5 are the claimed “add on elements” when in fact the DE '705 reference itself states that these elements that are designated by the numeral 5 are not “add on elements” at all, but rather are “profile elements,” the Final Action is fatally flawed. It is not permissible to interpret a Section 102 reference outside of its express or inherent disclosure. It is not permissible to interpret a Section 102 reference so as to contradict its express disclosure, as the present Final Action has done.

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Moreover, Applicant's independent claim 21 requires (emphasis added):

using a grooved roller to **grind** connection surfaces for add on elements of the fixed track into the **prefabricated concrete part**

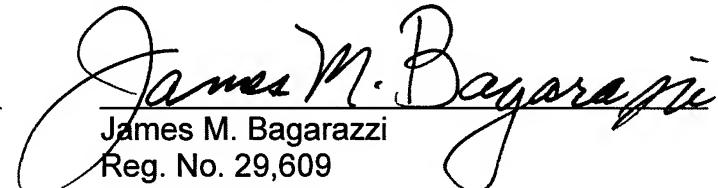
The DE '705 reference uses a milling process or cutting process, which are far less precise than a grinding process called for in Applicant's independent claims 21, 22, 24 and 28. Similarly, Applicant's independent claim 30 calls for a **grinding machine**, while the DE '705 reference only discloses a milling machine or cutting machine. Yet the Office never has accounted for this deficiency in the DE '705 reference.

Applicant therefore respectfully submits that the Final Rejection should be reversed, and the rejected claims should be allowed and passed to issue.

Respectfully submitted,

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